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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,701	06/01/2001	Steven W. Lundberg	296.022US1	2505

7590

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EXAMINER

AMSBURY, WAYNE P

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 08/05/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/872,701

Applicant(s)

LUNDBERG, STEVEN W.

Examiner

Wayne Amsbury

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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CLAIMS 1-96 ARE PENDING

1. It is noted that Applicant did not provide an identification of the provisional application upon which priority is apparently desired. From Office internal evidence, and in the interest of compact prosecution, the date of 29 March 2001 for 60/280,386 was applied with respect to prior art, but priority has not been granted.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwai et al (Iwai), US 5,175,681, 29 December 1992 in light of Immerman et al (Immerman), 6,574,617, 3 June 2003.

Iwai is directed to managing the preparation and prosecution of patent applications [COL 1 lines 11-13]. Iwai is not explicit about the use of modules to organize computation, but It would have been obvious to one of ordinary skill in the art at the time of the invention to apply modular programming to the tasks of Iwai because of the well known advantages of such programming, including efficiency and ease of debugging.

As to **claim 1**, the database that contains application and prosecution history [FIG 1, 10; COL 4 lines 22-55 and elsewhere] corresponds to the matter module; the step table steps correspond to the tasks module. Iwai does not explicitly address the security aspect of patent application management, but this is an inherent feature of such management. (The USPTO sets the standard by not making public any prosecution information concerning patent applications.)

It is also well known to apply a security model to application management as evidenced by Immerman [ABSTRACT; FIG 2; SUMMARY]. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a security model of management to the system of Iwai because that system requires security for applications by their nature.

The elements of **claims 2-11** of creating new matter, retrieving matter, editing matter and (user) creation of tasks are necessary components of managing patent applications, as noted in the Field of the Invention of Iwai [COL 1 lines 10-26 and elsewhere]. This passage also addresses particular users, particular organizations, and calendar information, and the SUMMARY addresses them again with respect to each aspect of the invention.

Immerman is directed at least in part to support of distributed computing and remote execution of web applications [COL 2 lines 9-13].

As to **claim 12**, Immerman provides security to databases through log in credentials [COL 5 lines 56-63]. As to **claim 13**, access to patent applications is controlled by the assignee, which corresponds to the creator of each matter or task.

As to **claims 14-17**, Immerman is a web-based mail-enabled system [SUMMARY] and elsewhere. As to **claim 20**, the protocol interfaces of Immerman include JAVA capability as a preferred embodiment [COL 8 line 16 and after]. As to **claims 18-24**, the notes replicas [FIG 3], synchronized databases [FIG 13], Notes sync manager [FIG 14] and other features of Immerman correspond to the elements of these claims in a variety of ways.

The elements of **claims 25-96** have been rejected in the above analysis, and these claims are rejected on that basis.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 703-305-3828. The examiner can normally be reached on M-TH 7-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

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WPA
July 23, 2003


WAYNE AMSBURY
PRIMARY PATENT EXAMINER